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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/737,211

12/16/2003

Andreas Junghans

tesa 1621-WCG

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27386

7590

03/08/2006

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EXAMINER

DESAI, ANISH P

ART UNIT

PAPER NUMBER

1771

DATE MAILED: 03/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/737,211	JUNGHANS ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Anish Desai	1771	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 December 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>9/14/05</u> . | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

The applicant's arguments in response to the Office action dated 09/16/05 have been fully considered.

1. All of the art rejections are maintained.
2. The obviousness-type double patenting rejections are maintained.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Luhmann et al. (US Patent 5,897,949) in view of Horiki et al. (US Patent 4,868,045) substantially as set forth in the 09/16/05 Office action.

Luhmann et al. teach an adhesive tape which can be redetached by pulling, without residue and without damage, having a foam backing coated on one or the both sides with a self-adhesive composition (see Abstract). The self-adhesive tape can be used in labels, signs, for joining materials which are to be parted at later point in time, sealing elements etc. (Column 3, lines 45-58). The self-adhesive tape contains block copolymers (Column 3, lines 60-61) and tackifiers (Column 4, line 16).

Luhmann et al. are silent as to teaching of a water-soluble polymer as claimed in claim 1, amount of water-soluble polymer as claimed in claims 2 and 3, and water-soluble polymers as claimed in claim 4. However, Horiki et al. teach a masking member

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that can be used to protect a surface. The masking member consists of an emulsion type adhesive coated onto a closed cell polystyrene foam (Abstract). Horiki et al. teach that it is necessary to prevent the adhesive layer from transferring from the masking member to a surface, which is to be protected (Column 1, lines 26-28). The adhesive of Horiki et al. contains a water-soluble polymer in the amount of about 0.1 to 20% by weight of the weight of the adhesive emulsion, which may increase the cohesive force of the adhesive and gives a releasing property to the adhesive (Column 1, lines 60-65). Additionally, the water-soluble polymer does not deteriorate stickiness and weatherability of the adhesive (Column 1, line 69). Moreover, Horiki et al. disclose that the use of a water-soluble polymer in more than 20% weight percent can cause the decrease in the stickiness of the adhesive (Column 3, lines 3-9). The water-soluble polymers used in the adhesive emulsion are polyvinyl alcohol, polyacrylamides, and polyvinyl pyrrolidone (Column 2, lines 60-68, Column 3, lines 1-2). Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add the water-soluble polymer in the amount disclosed in the invention of Horiki et al. in the adhesive of Luhmann et al., motivated by the desire to improve the weatherability of the adhesive and prevent the deterioration of the stickiness of the adhesive.

Regarding the claims 5 and 6, the pressure sensitive adhesive of Luhmann et al. contains plasticizers, light stabilizers, antioxidants, and fillers such as silica, glass, alumina, zinc oxides, calcium carbonate, titanium dioxides, and carbon black (Column 4, lines 31-39). Regarding the claims 7, please see the previously disclosed invention of Luhmann et al.

### ***Double Patenting***

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-7 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-7 of copending Application No. 10/739,705 substantially as set forth in 09/16/05 Office action.

### ***Response to Arguments***

4. Applicant's arguments filed 12/27/05 have been fully considered but they are not persuasive.
5. The obviousness-type double patenting rejections will not be withdrawn until the submission of the terminal disclaimer.
6. The art rejection over Luhmann et al. (US 5,897,949) in view of Horiki (US 4,868,045) is maintained for the following reasons.

The applicant argues that nothing in Horiki teaches or suggests anything at all about an adhesive that is redetachable by stretching. The examiner agrees with the applicant. However, the examiner is not relying on Horiki for the redetachment of adhesive by stretching. Instead the examiner is relying on Luhmann, which clearly

teach at Column 2, lines 47-48 that the adhesive film can be redetached without residue and without destruction by stretching especially in the bond plane.

The applicant argues that Horiki does not teach or suggest anything at all about improving weatherability but rather only avoiding the deterioration of weatherability. Further Horiki does not teach or suggest that the water-soluble polymer improves the weatherability. The examiner respectfully disagrees. The examiner acknowledges that Horiki does not explicitly teach the water-soluble polymer of the improvement of weatherability but only the prevention of deterioration of weatherability. However, Horiki clearly teach that the adhesive layer comprising water-soluble polymer has an excellent weatherability. Thus, a skilled artisan would have found it obvious to add the water-soluble polymer of Horiki in the adhesive of Luhmann to provide better (improve) weatherability to the adhesive layer. Further note that Under Section 103, the obviousness of an invention cannot be established by combining the teachings of the prior art references absent some teaching, suggestion or incentive supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). **This does not mean that the cited prior art references must specifically suggest making the combination.** *B.F. Goodrich Co. M Aircraft Braking Systems Corp.*, 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996); *In re Nilssen*, 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988)). Rather, the test for obviousness is what the combined teachings of the prior art references would have suggested to those of ordinary skill in the art. *In re Young*, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991); *In re Keller*, 642 F.2d 413, 425,

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208 USPQ 871, 881 (CCPA 1981). This test requires us to take into account not only the specific teachings of the prior art references, but also any inferences which one skilled in the art would reasonably be expected to draw therefrom. *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

The applicant argues that weatherability is not a concern for Luhmann and nothing in the exemplary applications indicated at Col 3, lines 45-58 of Luhmann reference would raise any concerns about weatherability. The examiner respectfully disagrees. The examiner respectfully points out that the adhesive tape of Luhmann has applications such as in fixing of posters, pictures, and sealing elements. Note that the applications such as fixing of posters, pictures, and sealing elements as taught by Luhmann are known to be used indoor as well as outdoor, which would necessarily require consideration of weatherability.

The applicant argues that since the Luhmann's adhesive is residueless, there is no reason why any person skilled in the art would be motivated to add anything to it to prevent the adhesive layer from transferring to the surface of an article, which Luhmann's adhesive already is capable of doing so. Further the applicant argues that it is more likely that those skilled in the art would think a water-soluble polymer would be detrimental to Luhmann's adhesive, by making it more likely to absorb water and deteriorate. The examiner respectfully disagrees. The examiner recognizes that Luhmann's adhesive is redetachable from the surface without leaving any residue. However, the Horiki reference is relied upon not only to show that the adhesive layer comprising water-soluble polymer has large cohesive force so that the adhesive layer

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would be prevented from transferring to the surface of the article, but also to show that the adhesive comprising water-soluble polymer of Horiki has an excellent weatherability, excellent heat resistance, and prevention of the deterioration of stickiness. With respect to the applicant's argument that it is more likely that those skilled in the art would think a water-soluble polymer would be detrimental to Luhmann's adhesive, by making it more likely to absorb water and deteriorate. The argument is not found to be persuasive in determination of patentability because the argument is based on applicant's personal opinion and not based on any factual evidence. Accordingly the art rejection is maintained.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anish Desai whose telephone number is 571-272-6467. The examiner can normally be reached on Monday-Friday, 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

APD

  
**HAI VO**  
**PRIMARY EXAMINER**